

REMARKS

Claims 1-7 were pending in the Application. Applicants cancelled claim 7 without prejudice or disclaimer. Hence, claims 1-6 are pending in the Application. Applicants cancelled claim 7 only to expedite the issuance of claims 1-6 and not in response to the Examiner's rejections. Applicants are not conceding in this application that cancelled claim 7 is directed to non-statutory subject matter or fails to comply with the written description requirement, as the present claim amendments and cancellations are only for facilitating the expeditious prosecution of the subject matter (claims 1-6) indicated by the Examiner as being allowable (see below). Applicants respectfully reserve the right to pursue cancelled claim 7 and other claims in one or more continuation patent applications.

The amendments made to claim 1 were to advance prosecution and are not an admission that these amendments were necessary to overcome the Examiner's 35 U.S.C. §101 rejections. Claim 1 was amended to include the aspect of marking the document as archived when an agent is finished. Support for this limitation is found at least in part on page 4, line 12 of Applicants' Specification. Further, claim 1 was amended to include the aspect of the customized code forming the agent. Support for this limitation is found at least in part in claim 4.

Further, claim 4 was amended to cancel the limitation of "wherein the customized code forms an agent" which was included in claim 1.

Further, claim 6 was amended to cancel the phrase ", if any," to correct typographical mistakes.

Hence, no prosecution history estoppel arises from the amendments to claims 1, 4 and 6. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 1, 4 and 6 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

Applicants thank Examiner Parthasarathy for discussing the 35 U.S.C. §101 rejections and obviousness-type double patenting rejections with Applicants' attorney, Bobby Voigt, on June 9, 2008. Examiner Parthasarathy agreed to allow claims 1-6, with the present claim amendments, as discussed herein.

As was discussed with Examiner Parthasarathy, the rejections under 35 U.S.C. §101 in connection with pending claims 1-5 are overcome by including the limitations of marking the document as archived when an agent is finished, wherein the customized code forms the agent.

Further, as was discussed with Examiner Parthasarathy, the rejections on the ground of non-statutory obviousness-type double patenting in connection with pending claims 1-6 are overcome based on the arguments presented herein.

The Examiner has rejected pending claims 1-6 based on non-statutory obviousness-type double patenting in view of claims 1-8 of U.S. Patent No. 6,944,815. Office Action (5/15/2008), page 4.

In determining whether a non-statutory basis exists for a double patenting rejection, the first question to be asked is—does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? M.P.E.P. §804. A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. §103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 U.S.P.Q. 29 (C.C.P.A. 1967); M.P.E.P. §804. Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 U.S.P.Q.2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 U.S.P.Q. 645 (Fed. Cir. 1985).

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. §103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459

(1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. §103 are employed when making an obvious-type double patenting analysis. M.P.E.P. §804. However, the Examiner has not made any such inquiry. The Examiner has not made any factual inquiries (1) to determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue; (2) to determine the differences between the scope and content of the patent claim and the prior art as determined in (1) and the claim in the application at issue; (3) to determine the level of ordinary skill in the art; and (4) to evaluate any objective indicia of nonobviousness. M.P.E.P. §804. Any obviousness-type double patenting rejection should make clear the differences between the inventions defined by the conflicting claims—a claim in the patent compared to a claim in the application. M.P.E.P. §804. Further, any obviousness-type double patenting rejection should include reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent. M.P.E.P. §804. The Examiner has not made clear the differences between the inventions claimed in the application and the claims in the cited patent. Consequently, in view of the foregoing, the Examiner has not provided a basis for an obviousness-type double patenting rejection of pending claims 1-6. Thus, the rejections of claims 1-6 under obviousness-type double patenting are improper.

In particular, the Examiner has not determined the scope and content of the patent claim relative to a claim in the application at issue, but instead, in the discussion on June 9, 2008 with Applicants' Attorney, pointed out to references in the specification of the patent (U.S. Patent No. 6,944,815) as allegedly teaching various limitations in the claims in the application at issue. The disclosure of a patent cited in support of a double patenting rejection cannot be used as though it was prior art, even where the disclosure is found in the claims. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 23 U.S.P.Q.2d 1839, 1846 (Fed. Cir. 1992). Instead, the claims of the patent are used as the basis for a double patenting rejection. *Id.*

As stated above, the Examiner is to first determine the scope and content of the patent claim (claims in U.S. Patent No. 6,944,815) relative to a claim in the

application at issue. That is, the Examiner is to compare each entire claim individually in the patent (U.S. Patent No. 6,944,815) relative to each claim in the application individually. In this manner, the Examiner would then be determining whether the invention defined by a claim in the patent (U.S. Patent No. 6,944,815) is merely an obviousness variation of an invention claimed in the application at issue. For example, claim 1 of U.S. Patent No. 6,944,815 recites the following:

A method for handling content off-loading from documents in a document processing system to a repository, comprising the steps of:

storing a copy of an original document from the document processing system in the repository;

stripping the content from the original document in the document processing system to form a stub document, the stub containing at least information to enable automatic retrieval of the stored document from the repository when the stub document is selected by a user; and

maintaining the stub document in the document processing system.

Claim 1 in the present application currently recites the following:

A method for processing documents being off-loaded in a document processing system in which requests are executed by an off-loading process, said method comprising the steps of:

providing customized code for execution during the off-loading process;

invoking the customized code when an off-loading request is issued relative to a document in the document processing system synchronously to the off-loading process; and

marking the document as archived when an agent is finished, wherein the customized code forms the agent.

Claim 1 in the present application is clearly not an obvious variation of claim 1 of U.S. Patent No. 6,944,815. There is no mention in claim 1 of the present application as to storing a copy of an original document in a repository; or stripping the content from the original document to form a stub document; or having a stub contain at least information to enable automatic retrieval of the stored document from

the repository when the stub document is selected by a user; or maintaining the stub document, as recited in claim 1 of U.S. Patent No. 6,944,815. Claim 1 of the present application is clearly not an obvious variation of claim 1 of U.S. Patent No. 6,944,815.

Thus, the rejections of pending claims 1-6 under obviousness-type double patenting are improper.

As a result of the foregoing, it is asserted by Applicants that claims 1-6 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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